

REMARKS

Amendments to the Claims

The pending claims have been amended so that they relate to the classification, stratification, etc. of breast tumors. This amendment finds support throughout the application as filed (e.g., see claims 11, 44, 56 and 68). No new matter has been added.

Claims 11, 44, 56 and 68 that were already limited to breast tumors have been canceled since they would be duplicates of claims 10, 43, 55 and 67, respectively. All claims drawn to non-elected inventions have been canceled (i.e., claims 1-2, 4, 13-14, 16, 23-24, 26, 33-34, 36, 45-46, 48, 57-58, 60 and 69-122). The dependencies of claims 5, 10, 12, 22, 32, 37, 42, 43, 49, 54, 55, 61, 66 and 67 have been amended so that they relate to the elected invention.

Applicant has also added method objectives for claim 3 (method of classifying a breast tumor); claim 35 (method of providing diagnostic, prognostic, or predictive information about a subject having a breast tumor); claim 47 (method of stratifying a subject having a breast tumor for a clinical trial); and claim 59 (method of selecting a treatment for a subject having a breast tumor). In addition, claim 15 (method of providing diagnostic, prognostic, or predictive information for a breast tumor) and claim 25 (method of selecting a treatment for a breast tumor) have been re-written in independent format instead of depending from claim 3. Claims 17 and 27 have also been re-written to depend from claims 15 and 25 instead of claim 5.

These amendments are made without prejudice, without intent to acquiesce in any rejection of record, and without intent to abandon any originally claimed subject matter. Applicant reserves the right to pursue the original claims in a continuation.

Interview and rejections

The undersigned and Dr. Brenda H. Jarrell, wish to thank Examiner Canella for according them a telephone interview on January 27, 2005.

At the beginning of the Interview we indicated that Applicant would be willing to amend the claims to breast tumors. We noted that the Examiner suggested this amendment in the Final

Office Action as a means of overcoming the enablement and novelty rejections (see item 6, last sentence of first paragraph on page 5 and item 9 on page 6). The Examiner kindly confirmed that such an amendment would indeed overcome both of these rejections.

The discussion then turned to the rejection under 35 U.S.C. § 101 (see items 4-5 of Final Office Action). The Examiner clarified that this rejection was originally made because the claims as pending were drawn to all tumors, not just to breast tumors. The Examiner then indicated that amending the claims to breast tumors would also overcome this rejection. In particular, the Examiner explained that, based on the teachings of the present application, the steps of classifying, stratifying, etc. breast tumors would not require abstract reasoning.

The written description rejection (see item 3 of Final Office Action) was not discussed during the Interview. However, as noted above, the present amendment has added method objectives to claims 3, 35, 47 and 59 and re-written claims 15 and 25 in independent format (with their own method objectives). Applicant respectfully submits that these amendments address the Examiner's reasons for rejecting the claims for lack of written description rejection and that this rejection should also be withdrawn.

Conclusion:


Based on the Interview, the Amendments and Remarks presented herein, it is submitted that the pending claims in this case are in condition for allowance. Applicant would again like to thank the Examiner for granting a telephone interview and for her thoughtful comments and careful consideration of the case. If it is believed that a telephone conversation would help expedite prosecution of this case, or if any further information is required, the Examiner is

RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE

invited to contact the undersigned at (617) 248-4793. Additionally, please charge any fees that may be required, or credit any overpayment, to our Deposit Account No. 03-1721.

Respectfully submitted,
CHOATE, HALL & STEWART, LLP

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Limited Recognition under 37 C.F.R. § 11.9(b)

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